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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,469	01/18/2006	Thilo Dollase	101769-310-WCG	3249
27386 7590 08/31/2009 NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022				
EXAMINER				
CHANG, VICTOR S				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
08/31/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,469

Applicant(s)

DOLLASE ET AL.

Examiner

VICTOR S. CHANG

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2009 and 20 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6 and 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Introduction

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' amendments and remarks filed on 7/7/2009 and 7/20/2009 have been entered. Claim 1 has been amended. Claims 1, 2, 4-6 and 8-15 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to the amendments, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

Rejections Based on Prior Art

4. Claims 1, 2 and 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 10-025460 [machine translation].

JP '460 relates to an acrylic pressure-sensitive adhesive composition. The composition comprises block copolymer represented by the formula $(A-B)_a-A$, wherein A block is a vinyl polymer, B block is a polymer of a 1-12C alkyl (meth)acrylate, and $a = 1$ to 10. For example, an A-B-A block copolymer has A blocks of n-butyl acrylate and B block of methyl methacrylate [abstract]. The adhesive can be used to form a pressure sensitive adhesive sheet, etc., on one

side or both sides of a base material, such as paper, etc. [0058 and 0060]. The binder (adhesive) layer can be hot melt coated by an extruder onto the base material [0059].

For claims 1, 2 and 8, JP '460 is silent about the glass transition temperatures (T_g), the immiscibility of the polymer blocks, and the adhesiveness of the polymer blocks. However, these physical properties are deemed to be inherent to the same chemistry which is anticipated by JP '460. Specifically, as shown in the specification of instant application, block P(A) includes poly(n-butyl acrylate) (a polymer of acrylic esters with alkyl groups having 4 to 14 carbon atoms) [page 15], and block P(B) includes poly(methyl methacrylate) [page 16], therefore the A block and B block of JP '460 read on the P(A) and P(B) of the claimed invention, respectively. Regarding newly added limitation of ratio of chain lengths of the P(A) and P(B) blocks, and its resultant effect of P(B) as a dispersed phase in a continuous matrix formed of P(A), since JP '460 teaches generally the same structure and composition for the same end use as the claimed invention, a workable ratio is deemed to be either anticipated, or an obvious routine optimization to one of ordinary skill in the art, motivated by the desire to obtain the same required adhesive properties for the same end use as the claimed invention. It should be noted that since the chemistry dictates the properties of the P(A) and P(B) blocks, it necessarily requires a continuous matrix formed of P(A), because it is the block providing required adhesiveness for use. A continuous matrix formed of P(B), which is non-adhesive, would have rendered the composition useless as a pressure sensitive adhesive.

5. Claims 4, 5, 6 and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-025460 [machine translation].

The teachings of prior art are again relied upon as set forth above.

For claims 4, 5 and 10, JP '460 is silent about the use of release layer and adhesion promoting primer layer. However, absence of any evidence to the contrary, the Official notice "these layers are common and well known" has been taken as admitted prior art. It would have been obvious to one of ordinary skill in the art to incorporate that layers in adhesive sheets formed from the adhesives of JP '460, motivated by the desire to improve the release property of individual adhesive sheets from a multilayered adhesive pad; and to enhance the adhesion between the adhesive layer and support, respectively.

For claims 6 and 12-15, JP '460 is silent about providing the pressure sensitive adhesive sheet in the form of a pad of plurality of adhesive sheets. However, absence of any evidence to the contrary, the Official notice "providing a plurality of adhesive sheets in the form of a pad of conveniently predetermined size is common and well known" has been taken as admitted prior art.

For claim 9, since JP '460 teaches the same chemistry of the binder (adhesive) composition, forming the layer by the same melt extrusion process [see specification page 9, line 34], and for the same end use as the claimed invention, workable refractive indices of the block copolymers are deemed to be either anticipated, or obviously provided by practicing the invention of prior art for the same end use.

For claim 11, selecting a commercially acceptable color for the paper support of an adhesive sheet product is deemed to be obviously provided by practicing the prior art for the same end uses.

Response to Arguments

6. Applicants' arguments at Remarks pages 5-11 have been carefully considered. However, for reasons set forth above in the updated grounds of rejection, applicants' arguments have been addressed and rendered moot.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR S. CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/
Primary Examiner, Art Unit 1794